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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ AT&T Delaware Intellectual Property, Inc. 600 GALLERIA PARKWAY, S.E. SUITE 1500 ATLANTA, GA 30339-5994			NEURAUTER, GEORGE C	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/750,138

Filing Date: December 29, 2000

Appellant(s): MALIK, DALE W.

Benjamin A. Balser, Reg. No. 58,169
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 December 2007
appealing from the Office action mailed 26 January 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,842,768 SHAFFER et al 1-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8, 15, and 21-45 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 842 768 B1 to Shaffer et al.

Regarding claim 1, Shaffer discloses a method for automatically managing an electronic mail server application on a host computer, comprising the steps of:

checking an electronic mail message against a predetermined criteria; determining whether the message has been previously compressed; compacting ("compressing") a non-attachment portion (referred to within the reference as "message") of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and storing the compacted electronic mail message. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account..."; column 6, lines, 65-67, "The figure shows a representation of multimedia email system 210 with individual original messages 252 and !compressed (sp) messages 254.")

Regarding claim 2, Shaffer discloses the method of claim 1, wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application. (column 3, lines 25-29, "Device 130 represents any type of device or system or network that provides data to user information appliances, such as, but not limited to...an email server..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed

version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account...") (Examiner's note: Note that it is inherent within the reference that email servers receive and store messages for clients before the clients access their email account).

Regarding claim 3, Shaffer discloses the method of claim 1, wherein the step of checking is performed when the electronic mail message is performed periodically on the host computer. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account or the file may be compressed on-the-fly as a user logs in or as a user requests download of a particular message")

Regarding claim 6, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises a total message size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a

compressed version of the data file available for transmission.")

Regarding claim 7, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises an attachment size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 8, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises an attachment type. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission."); column 8, lines 7-10, "Other parameters according to the invention may indicate what decoding formats can be handled by the client and therefore allow a server to determine desired compression formats.")

Regarding claim 15, Shaffer discloses the method of claim 1, further comprising the step of compressing the attachment.

Art Unit: 2100

(column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 21, Shaffer discloses a method for managing a user's electronic mailbox on a computer, comprising the steps of performing an off-peak hours routine (column 8, lines 30-34, "An intelligent component of the system might also defer performing any pre-compression while the computer system is experiencing heavy use or might defer pre-compression") for checking an electronic mail message against a predetermined criteria; compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns (column 8, lines 45-56); and storing the compressed electronic mail message. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever

Art Unit: 2100

accesses an email account..."; column 6, lines, 65-67, "The figure shows a representation of multimedia email system 210 with individual original messages 252 and !compressed (sp) messages 254.")

Regarding claim 22, Shaffer discloses the method of claim 21, wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox. (column 3, lines 25-29, "Device 130 represents any type of device or system or network that provides data to user information appliances, such as, but not limited to...an email server..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account...") (Examiner's note: Note that it is inherent within the reference that email servers receive and store messages for clients in their respective accounts or "mailboxes" before the clients access their email account).

Regarding claim 23, Shaffer discloses the method of claim 21, wherein the step of checking is performed upon request by the user. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed

version of the data file available for transmission. This compressed data file...or the file may be compressed on-the-fly as a user log ins or as a user requests download of a particular message.")

Regarding claim 26, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises a total message size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 27, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises an attachment size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 28, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises an attachment type. (column 2, lines 39-48, specifically "...the size of the

data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission."; column 8, lines 7-10, "Other parameters according to the invention may indicate what decoding formats can be handled by the client and therefore allow a server to determine desired compression formats.")

Regarding claims 30-32, Shaffer discloses the method of claim 21, wherein the location of the screening of the message is on a server, a client, or configured by a user. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message... In specific embodiments, a user may indicate (either at the time of transfer, the time of login, or during client setup) an acceptable delay or desired compression for a transfer."; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 33, Shaffer discloses the method of claim 21, wherein the screening is performed periodically on the computer. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed

version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account or the file may be compressed on-the-fly as a user logs in or as a user requests download of a particular message")

Regarding claim 34, Shaffer discloses the method of claim 21, wherein the electronic mail message is compressed into a zipped file. (column 8, lines 45-56, specifically "It should be understood that a data file or a message may be encoded into a variety of compression formats. Some of these formats, such as ...ZIP...have built-in variable compression.")

Claims 35-42 are also rejected since these claims recite a computer readable medium that contain substantially the same limitations as recited in claims 21-23, 33, 26-28, and 34 respectively.

Regarding claim 43, Shaffer discloses the method of claim 1, further comprising decompacting the compacted electronic mail message for retrieval. (column 5, lines 30-44, specifically "Optionally, there may also be a selectable option that a user can use to indicate that the system should download a compressed file or original file according to default rules. Selection by a user is registered by the client-side logic (Step B3) and is communicated so that the appropriate file format may be

transmitted (Step B4)."; column 8, lines 35-45, specifically "The server maintains information about which algorithms are available at a particular client and may learn from the client from time to time which algorithms are available at the client or desired by the user such as via a compression format list 250. According to a further embodiment, a server can in some instances download to the client an application or applet 240 to enable the client to handle a particular type of compressed file")

Claims 44 and 45 are also rejected since these claims recite a method and computer readable medium that contains substantially the same limitations as recited in claim 43.

(10) Response to Argument

The Applicant argues that Shaffer does not teach or suggest determining whether an electronic message has been previously compressed. The Examiner submits that Shaffer does in fact disclose this limitation at least in view of the disclosures of Shaffer.

As previously discussed in the final rejection mailed 26 January 2007 and the advisory action mailed 3 May 2007, Shaffer disclosed that "According to the invention, when indicated by the connection or channel speed and the message or attachment

Art Unit: 2100

size, a server makes a compressed version of the data file available for transmission." (column 7, lines 46-49) and that "A system according to a specific embodiment of the invention can use artificial intelligence type analysis in media server 210 or a cooperating software component to determine when or how to compress messages..." (column 8, lines 11-14)

In a conventional manner as is well known and used in the art, a file may be in two distinct states: in an uncompressed state in its existing file format and it may be compressed using various techniques into another format that allows the file's size to be reduced in order to save space in memory. Shaffer expressly disclosed, as shown above, that, based on a determination on a number of factors including message size, electronic mail messages are taken from their original and presumably uncompressed state and compressed into a smaller size.

The claim recites that a determination is made as to whether a message has been previously compressed. As explained by the Examiner, a file may either be uncompressed or compressed. If the server determines that an uncompressed message's size requires compression, it compresses the message. This teaching is in accordance with the recitations of the claim since the claim "compacts" a portion of the message "if the

message has not been previously compressed". Therefore, the message is in an uncompressed state and is then compressed or "compacted".

In the opinion of the Examiner, based on the teachings of Shaffer and in accordance with the specification and the claimed invention, if a file is determined to be previously compressed, it is already in the state of compression and would not be compressed further, as this would go against the teachings of Shaffer and, also, this situation is not treated by the claims. If the file is not previously compressed, it is compressed.

Therefore, it is submitted that Shaffer does in fact teach determining whether an electronic mail message has been previously compressed based upon its teachings that an uncompressed message is used to determine whether it should be compressed and, based on a determination that a message is in its current state of not being previously compressed, the non-attachment portion is subsequently compressed or "compacted" as claimed and as shown in Shaffer.

It is respectfully submitted that the rejections under Shaffer should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/George C. Neurauter, Jr./

Primary Examiner, Art Unit 2143

Conferees:

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151

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